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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO:
09/616,086	07/14/2000	Masaki Tamaru	32811	6585

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PEARNE & GORDON LLP
526 SUPERIOR AVENUE EAST
SUITE 1200
CLEVELAND, OH 44114-1484

EXAMINER

VU, HUNG K

ART UNIT	PAPER NUMBER
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2811

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/616,086	TAMARU ET AL.	
	Examiner	Art Unit	
	Hung K. Vu	2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 and 20-31 is/are pending in the application.

4a) Of the above claim(s) 4,5,7-16 and 20-31 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3,6 and 17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

. 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) Interview Summary (PTO-413) Paper No(s) _____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____ .

DETAILED ACTION

Request for Continued Examination

1 A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 03/19/03 has been entered. An action on the RCE follows.

Claim Objections

2. Claims 2, 3, 6 and 17 are objected to because of the following informalities: In claims 2, 3, 6 and 17, line 1, "A" should be changed to "The" for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 3, 6 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. (PN 5,311,048, of record).
Takahashi et al. discloses, as shown in Figures 1 and 7, a semiconductor device comprising,

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a first conductive layer (12) formed of a surface of a semiconductor substrate;

a second conductive layer (12) which is formed close to the first conductive layer,

wherein

the distance between adjacent conductive structures (the first conductive layer (12) and the second conductive layer (12)) is commonly determined by the permittivity of the insulating layer (10,13) encapsulating the conductive structures.

Note that the capacitance is obtained by the following equation:

$$C = \varepsilon \frac{A}{d}$$

wherein C = capacitance

ε = permittivity

A = surface area

d = distance

Thus, by keeping the surface area and the distance constant, the capacitance is directly proportional to the permittivity. And by keeping the capacitance and the surface area constant, the distance is directly proportional to the permittivity. Therefore, the permittivity of the insulating layer controls the capacitance between adjacent conductive structures. Effective control of this capacitance is essential in achieving the optimum electrical characteristics of a semiconductor device. So this particular limitation is held inherent in that the distance between the adjacent conductive structures is determined by the permittivity of the insulating layer. In alternative, this limitation (the distance between the adjacent conductive structures being determined by the permittivity of the insulating layer) deals with how the claimed device is

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made. Therefore, the claimed device must be directed to the product per se, no matter how actually made.

With regard to claim 2, Takahashi et al. discloses the second conductive layer is made of a conductive film being filled in a through hole being located close to the first conductive layer and passing through at least a part of the insulating film; and the first and second conductive layers are connected to first and second potentials (Vss, Vcc), respectively, and a capacitor, which extends in the depth direction of the through hole, is formed by using the insulating inter-layer film interposed between the first conductive layer and the second conductive layer within the through hole.

With regard to claim 3, Takahashi et al. discloses the through hole comprises a second through hole being electrically connected to a semiconductor region or a wiring region only at either of the opened ends thereof.

With regard to claim 6, Takahashi et al. discloses the first conductive layer is formed within a first through-hole being separated by a predetermined distance from the through-hole, whereby a vertical capacitor, which extends in the depth direction of the through-hole, is formed by the first and second conductive layers (12,12) and the insulating film (10,13) interposed between the first and second conductive layers.

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With regard to claim 17, Takahashi et al. discloses the through-hole into which the second conductive layer is filled is a first through-hole, the first conductive layer being filled in a second through-hole, and the upper ends thereof are connected to first and second metallic layers, and the spatial intervals in the arrays of the first and second metallic layers are smaller than those in the arrays of the first and second through-holes.

4. Claims 1 – 3, 6 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakanishi et al. (PN 4,954,877, of record).

Nakanishi et al. discloses, as shown in Figure 1B, a semiconductor device comprising, a first conductive layer (15) formed of a surface of a semiconductor substrate; a second conductive layer (15') which is formed close to the first conductive layer,

wherein

the distance between adjacent conductive structures (the first conductive layer (15) and the second conductive layer (15')) is commonly determined by the permittivity of the insulating layer (3) encapsulating the conductive structures.

Note that Nakanishi et al. discloses a chip carrier comprises a semiconductor material and is used to protect the chip from external contaminations, therefore, it is a part of the semiconductor device. Also note that the capacitance is obtained by the following equation:

$$C = \epsilon \frac{A}{d}$$

Thus, by keeping the surface area and the distance constant, the capacitance is directly proportional to the permittivity. And by keeping the capacitance and the surface area constant, the distance is directly proportional to the permittivity. Therefore, the permittivity of the

insulating layer controls the capacitance between adjacent conductive structures. Effective control of this capacitance is essential in achieving the optimum electrical characteristics of a semiconductor device. So this particular limitation is held inherent in that the distance between the adjacent conductive structures is determined by the permittivity of the insulating layer. In alternative, this limitation (the distance between the adjacent conductive structures being determined by the permittivity of the insulating layer) deals with how the claimed device is made. Therefore, the claimed device must be directed to the product per se, no matter how actually made.

With regard to claim 2, Nakanishi et al. discloses the second conductive layer is made of a conductive film being filled in a through hole being located close to the first conductive layer and passing through at least a part of the insulating film; and the first and second conductive layers are connected to first and second potentials (+,-), respectively, and a capacitor, which extends in the depth direction of the through hole, is formed by using the insulating inter-layer film interposed between the first conductive layer and the second conductive layer within the through hole.

With regard to claim 3, Nakanishi et al. discloses the through hole comprises a second through hole being electrically connected to a semiconductor region or a wiring region only at either of the opened ends thereof.

With regard to claim 6, Nakanishi et al. discloses the first conductive layer is formed within a first through-hole being separated by a predetermined distance from the through-hole, whereby a vertical capacitor, which extends in the depth direction of the through-hole, is formed by the first and second conductive layers (15,15') and the insulating film (3) interposed between the first and second conductive layers.

With regard to claim 17, Nakanishi et al. discloses the through-hole into which the second conductive layer is filled is a first through-hole, the first conductive layer being filled in a second through-hole, and the upper ends thereof are connected to first and second metallic layers, and the spatial intervals in the arrays of the first and second metallic layers are smaller than those in the arrays of the first and second through-holes.

5. Claims 1 – 3, 6 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (PN 5,598,029, of record).

Suzuki discloses, as shown in Figure 4, a semiconductor device comprising,
a first conductive layer (7a) formed of a surface of a semiconductor substrate;
a second conductive layer (7b) which is formed close to the first conductive layer,
wherein

the distance between adjacent conductive structures (the first conductive layer (7a) and the second conductive layer (7b)) is commonly determined by the permittivity of the insulating layer (17b,16b) encapsulating the conductive structures.

Note that the capacitance is obtained by the following equation:

$$C = \epsilon \frac{A}{d}$$

Thus, by keeping the surface area and the distance constant, the capacitance is directly proportional to the permittivity. And by keeping the capacitance and the surface area constant, the distance is directly proportional to the permittivity. Therefore, the permittivity of the insulating layer controls the capacitance between adjacent conductive structures. Effective control of this capacitance is essential in achieving the optimum electrical characteristics of a semiconductor device. So this particular limitation is held inherent in that the distance between the adjacent conductive structures is determined by the permittivity of the insulating layer. In alternative, this limitation (the distance between the adjacent conductive structures being determined by the permittivity of the insulating layer) deals with how the claimed device is made. Therefore, the claimed device must be directed to the product per se, no matter how actually made.

With regard to claim 2, Suzuki discloses the second conductive layer is made of a conductive film being filled in a through hole being located close to the first conductive layer and passing through at least a part of the insulating film; and the first and second conductive layers are connected to first and second potentials, respectively, and a capacitor, which extends in the depth direction of the through hole, is formed by using the insulating inter-layer film interposed between the first conductive layer and the second conductive layer within the through hole.

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With regard to claim 3, Suzuki discloses the through hole comprises a second through hole being electrically connected to a semiconductor region or a wiring region only at either of the opened ends thereof.

With regard to claim 6, Suzuki discloses the first conductive layer is formed within a first through-hole being separated by a predetermined distance from the through-hole, whereby a vertical capacitor, which extends in the depth direction of the through-hole, is formed by the first and second conductive layers (7a,7b) and the insulating film (17b,16b) interposed between the first and second conductive layers.

With regard to claim 17, Suzuki discloses the through-hole into which the second conductive layer is filled is a first through-hole, the first conductive layer being filled in a second through-hole, and the upper ends thereof are connected to first and second metallic layers, and the spatial intervals in the arrays of the first and second metallic layers are smaller than those in the arrays of the first and second through-holes.

Response to Arguments

6. Applicant's arguments filed 02/19/03 have been fully considered but they are not persuasive.

It is argued, at pages 2-4 of the Remarks, that Takahashi patent provides no discussion regarding capacitance permittivity, specific inductive capacitance, dielectric properties of any of the materials of the described device, therefore, the Takahashi device does not have optimized

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electrical characteristics and that the Takahashi device may not even need control of the capacitance issues. This argument is not convincing because Takahashi et al. discloses noises produced in the supply voltages would result in malfunctions in the internal circuits, such as loss of stored data of a flip-flop circuit. It is known that noises between the supply voltages would create the coupling capacitance. Takahashi et al. teaches the techniques to reduce or eliminate noises result in the supply voltages to optimize the electrical characteristics. Further, it is well known that the capacitance is obtained by the following equation:

$$C = \epsilon \frac{A}{d}$$

Thus, by keeping the surface area and the distance constant, the capacitance is directly proportional to the permittivity. And by keeping the capacitance and the surface area constant, the distance is directly proportional to the permittivity. Therefore, the permittivity of the insulating layer controls the capacitance between adjacent conductive structures. Effective control of this capacitance is essential in achieving the optimum electrical characteristics of a semiconductor device. So this particular limitation is held inherent in that the distance between the adjacent conductive structures is determined by the permittivity of the insulating layer. In alternative, this limitation (the distance between the adjacent conductive structures being determined by the permittivity of the insulating layer) deals with how the claimed device is made. Therefore, the claimed device must be directed to the product per se, no matter how actually made.

It is argued, at pages 4-6 of the Remarks, that the Nakanishi et al. patent is not a semiconductor device but is instead a carrier for a circuit chip that may be a semiconductor device. In response

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to applicant's arguments, the recitation a semiconductor device has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, Nakanishi et al. teaches a chip carrier comprises a semiconductor material and is used to protect the chip from external contaminations, therefore, it is a part of the semiconductor device.

It is argued, at paged 6-8 of the Remarks, that the Suzuki patent provides no discussion regarding capacitance permittivity, specific inductive capacitance, dielectric properties of any of the materials of the described device, therefore, the Suzuki device does not have optimized electrical characteristics and that the Suzuki device may not even need control of the capacitance issues. This argument is not convincing because Suzuki discloses noises generated at the supply voltage wirings would result in malfunctions in the semiconductor devices. It is known that noises between the supply voltages would create the coupling capacitance. Suzuki teaches the techniques to reduce or eliminate noises result in the supply voltages to optimize the electrical characteristics. Further, it is well known that the capacitance is obtained by the following equation:

$$C = \varepsilon \frac{A}{d}$$

Thus, by keeping the surface area and the distance constant, the capacitance is directly proportional to the permittivity. And by keeping the capacitance and the surface area constant, the distance is directly proportional to the permittivity. Therefore, the permittivity of the insulating layer controls the capacitance between adjacent conductive structures. Effective control of this capacitance is essential in achieving the optimum electrical characteristics of a semiconductor device. So this particular limitation is held inherent in that the distance between the adjacent conductive structures is determined by the permittivity of the insulating layer. In alternative, this limitation (the distance between the adjacent conductive structures being determined by the permittivity of the insulating layer) deals with how the claimed device is made. Therefore, the claimed device must be directed to the product per se, no matter how actually made.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung K. Vu whose telephone number is (703) 308-4079. The examiner can normally be reached on Mon-Thurs 7:00-4:30, alternate Friday 7:00-3:30, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (703) 308-2772. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Vu

May 21, 2003

Hung Vu